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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARDNER G. COURSON,
VINCENT J. MIRAGLIA,
BLANE A. ERWIN,
and PATRICK T. O'DONNELL

Appeal 2009-001491
Application 10/673,050
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Gardner G. Courson et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART and enter a new ground of rejection pursuant to 37 C.F.R. 41.50(b).²

THE INVENTION

This invention is “an integrated computer-based system for capturing and managing legal knowledge in making an assessment of the strengths and weaknesses of a lawsuit.” Specification [0001].

Claims 1 and 5, reproduced below, are illustrative of the subject matter on appeal.

1. A tool for developing litigation discovery materials, the tool comprising:
 - an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests;
 - a menu for gathering discovery related information in response to a request using said entry field;
 - storage of discovery related information gathered from said menu;

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Mar. 8, 2007) and Reply Brief (“Reply Br.,” filed Apr. 24, 2008), and the Examiner’s Answer (“Answer,” mailed Feb. 25, 2008).

form discovery materials; and
a discovery production mechanism to
combine stored discovery related information and
form discovery materials to produce discovery
items for use in the litigation.

5. A tool for recommending a decision in
litigation, the tool comprising:
 interfaces for gathering selected information
 relevant to the decision;
 storage for the gathered selected
 information;
 weighting values associated with each
 element of selected information;
 an analyzer for using the stored selected
 information and the associated weighting values to
 determine a resultant value;
 resultant values associated with various
 decision options; and
 a recommendation element using the
 determined resultant value and the associated
 decision options to provide a recommended
 decision.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

Newell

US 2003/0112270 A1

Jun. 19, 2003

The following rejections are before us for review:

1. Claims 5-12 are rejected under 35 U.S.C. § 112, 1st paragraph
for failing to enable one of ordinary skill in the art to make and
use the claimed invention.

2. Claims 1-12 are rejected under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.
3. Claims 1-12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
4. Claims 1-12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Newell.

ISSUES

The first issue is whether claims 1-4 are indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention under 35 U.S.C. § 112, second paragraph. Specifically, the issue is whether claim 1 is indefinite because it encompasses a method and an apparatus.

The second issue is whether claims 5-12 are indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention under 35 U.S.C. § 112, second paragraph.

The third issue is whether claims 5-12 are directed to statutory subject matter under 35 U.S.C. § 101. Specifically, the major issue is whether claims 5-12 are directed to an apparatus.

The fourth issue is whether claims 5-12 fail to enable one of ordinary skill in the art to make and use the invention of claims 5-12 under 35 U.S.C. § 112, first paragraph. Specifically, the issue is whether the Examiner has established a prima facie showing in rejecting claims 5-12 under 35 U.S.C. § 112, first paragraph.

The fifth issue is whether claims 5-12 are anticipated under 35 U.S.C. § 102(e) by Newell. Specifically, the issue is whether the Examiner has established that Newell anticipates claims 5-12.

ANALYSIS

The rejection of claims 1-4 under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The Examiner rejects claims 1-12 under 35 U.S.C. § 112, 2nd paragraph as indefinite. App. Br. 11-13 and Reply Br. 35-42. The Examiner finds the claims indefinite because it is unclear what statutory class they invention fall into. *Id.* The Examiner states: “The [A]ppellant simply identifies the invention as a tool. However, there is no clear structure identified and there are no clear method steps being performed.” App. Br. 35-36. The Appellants respond:

Applicants submit that present claims are properly classified as apparatus or system claims. The present claims are a combination of graphical user interface elements and related data field (*See* claim 1, entry field and menu), physical storage (*See* claim 1, storage), stored information (form discovery materials), and a generally computer-

implemented process (discover production mechanism).

App. Br. 18.

A claim is considered indefinite under 35 U.S.C. § 112, second paragraph, if it does not reasonably apprise those skilled in the art of its scope. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005).

We are not persuaded by the Appellants' argument that claims 1-4 are directed to an apparatus and that "[e]ach element clearly falls into the apparatus classification, so the whole invention must then also into the apparatus classification." App. Br. 18. The Appellants' argument is overly narrower and is not commensurate in scope with what is claimed. Claim 1's recitation of an entry field and a menu does not require a graphical user interface, as the Appellants seem to argue (*see* App. Br. 18). Further, we note that contrary to the Appellants' own argument, the Appellants have construed the discovery production mechanism as a "computer-implemented process" (*Id.*). If we adopt this construction, claim 1 would comprise elements and a step of using these elements. This would cause the claim to be indefinite because it does not reasonably apprise those skilled in the art of the statutory class of invention the claim is directed to. *See IPXL Holdings*, 430 F.3d at 1384.

Arguably, the only structural element recited in claim 1 is the "storage." We see no other element of claim 1 that can be reasonably construed to require a device, and an apparatus (i.e. machine) consists of a plural parts or devices.

The Supreme Court has defined the term "machine" as "a concrete thing, consisting of parts,

or of certain devices and combination of devices.”
Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570
(1863). This “includes every mechanical device or
combination of mechanical powers and devices to
perform some function and produce a certain effect
or result.” *Coring v. Burden*, 56 U.S. 252 267
(1854).

In re Nuijten, 500 F.3d 1346, 1355 (Fed. Cir. 2007). Therefore, it would be unreasonable to construe the claim 1 to require an apparatus, as the Appellants argue.

We find that claim 1 does not reasonably apprise those skilled in the art of its scope because it is ambiguous as to what statutory class of subject matter is encompassed by the claim. Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Accordingly, we find that the Appellants have not overcome the Examiner rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The rejections of claims 1-4 under 35 U.S.C. § 101 and 35 U.S.C. § 102.

Claims 1-4 are indefinite for the reasons discussed above. The other rejections of claims 1-4 under 35 U.S.C. § 101 and U.S.C. § 102(e) must fall, pro forma, because they necessarily are based on speculative assumptions as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Accordingly, we reverse these rejections.

The rejection of claims 5-12 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The Examiner rejected claims 5-12 as indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regards as the invention. Answer 11-13. *See also* Answer 38-41. The Examiner finds the claims indefinite because it is unclear what statutory class they invention fall into. *Id.* The Examiner also rejected claim 8 because claim 8 is “unclear” since it recites “a tool” in the preamble but requires “a plurality of tools according to claim 5” in the body. Answer 13. *See also* Answer 41-42.

Turning to the rejection of claims 5-12, the Examiner finds the claims indefinite because it is unclear what statutory class they invention fall into. Answer 11-13. *See also* Answer 38-41. The Appellants respond by asserting that claims 5-12 are directed to an apparatus. App. Br. 17-19 and Reply Br. 8.

We agree with the Appellants that these claims are not indefinite and are directed to an apparatus (i.e. machine).

The Supreme Court has defined the term “machine” as “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). This “includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.” *Coring v. Burden*, 56 U.S. 252 267 (1854).

In re Nuijten, 500 F.3d 1346, 1355 (Fed. Cir. 2007).

A discussed above with regards to claim 1, “storage” is arguably reasonably construed as structure. Further, unlike claim 1, claim 5 does recite “interfaces,” which we find is reasonably construed as structure. Given that claim 5 recites at least these two parts or devices, we find that claim 5 is directed to an apparatus.

We note that the Examiner appears to consider the limitation “weighting values associated with each element of selected information” to be a method step (Answer 38) and that the Appellants do not challenge this construction (*See* App. Br. 18-20 and Reply Br. 8). Assuming that this limitation is properly construed as a method step, we still find that claim 5 is not ambiguous. Unlike claim 1 above, this “step” is not a step of using the recited elements.

We find that claims 5-12 are not insolubly ambiguous as to which statutory class of subject matter they encompass.

Turing to the rejection of claim 8, the Examiner found that claim 8 was “unclear” because the claim recites “a tool” in the preamble but recites a plurality of tools according to claim 5 in the body of the claim. Answer 13. *See also* Answer 41-42.

The Appellants responds:

Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to asses a lighting. Thus claim 8 utilizes the various decisions provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation.

App. Br. 19-20. *See also* Reply Br. 10.

We agree with the Appellants and find that claim 8 is not insolubly ambiguous. Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

Accordingly, we find that the Examiner has not established that claims 5-12 are indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The rejection of claims 5-12 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner rejected claims 1-2 under § 101 as being directed to non-statutory subject matter because 1) the claimed subject matter does not fall into one of the four recognized statutory classes of invention (Answer 42-45) and 2) the claimed invention does not produce a useful, concrete, and tangible result (Answer 45-64). The Appellants respond that the claims recite a “tool” is clearly an apparatus. App. Br. 20-22 and Reply Br. 10-12.

As discussed above with regards to the rejection of claims 5-12 under 35 U.S.C. § 112, second paragraph, we find that claim 5 is directed to a machine (i.e., apparatus) which is one of the four statutory classes of invention. Accordingly, we find that the rejection of claims 5-12 under 35 U.S.C. § 101 as being directed to non statutory subject matter is overcome.

The rejection of claims 5-12 under 35 U.S.C. § 112, first paragraph for failing to enable one of ordinary skill in the art to make and use the claimed invention.

The Examiner rejected claims 5-12 as failing to comply with the enablement requirement. Answer 4-11. *See also* Answer 17-35. The Appellants traverse this rejection. *See* App Br. 12-14 and Reply Br. 3-6.

We find that the Examiner has not established a prima face showing that one of ordinary skill in the art would not be enabled to make and use the claimed invention. “[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without [‘]undue experimentation.[‘]” *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993) (citation omitted). Some experimentation, even a considerable amount, is not “undue” if, e.g., it is merely routine, or if the specification provides a reasonable amount of guidance as to the direction in which the experimentation should proceed. *In re Wands*, 858 F.2d 7631, 737 (Fed. Cir. 1988). Factors to consider include:

- (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.[¶]

Wands, 858 F.2d at 737 (footnote omitted). While the Examiner argues that undue experimentation would be required to make and use the invention (*For example, see* Answer 9), the Examiner does not address the *Wands* factors above to support their argument. Accordingly, we find that the Examiner has not established a prima facie case that claims 5-12 fail to

enable one of ordinary skill in the art to make and use the claimed invention under 35 U.S.C. § 112, first paragraph, and we reverse this rejection.

The rejection of claims 5-12 under 35 U.S.C. § 102(e) as being anticipated by Newell.

The Appellants argue that the Examiner fails to make a prima facie showing of anticipation and ignores some limitations of claim 5 including, the limitations regarding the weighting values and assessor. App. Br. 24-25 and Reply Br. 14-15. In rejecting claim 5 under 35 U.S.C. § 102(e), the Examiner states that given the rejection of claim 5 under 35 U.S.C. § 112, second paragraph, “the claims are construed and the art is applied as much as practically possible” (Answer 16, emphasis omitted), but makes no findings or mention of these limitations (*See* Answer 17). Further, when responding to the Appellants’ argument, the Examiner also does not address these limitations. *See* Answer 69-71. Given this, we find that the Examiner has failed to establish a prima facie showing of anticipation in rejecting claim 5. It is well settled that in order for the Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Accordingly, we find that the Appellants have overcome the rejection of claim 5, and claims 6-12, dependent thereon, under 35 U.S.C. § 102(e) as anticipated by Newell.

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 103(a) on claims 5-12.

For this rejection, we make the following findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Figure 1A and 1B of the instant application are prior art and depict a flowchart of the methodology involved in making an assessment in an employment lawsuit. Specification [00003] and [00016].
2. Figure 1A depicts steps of gathering information, such as “Obtain Palintiff’s Medical Release of Records for Compensatory Analysis” and “On-site Investigation.”
3. Figure 1B includes a step of “Analyze: Success/Vulnerability of Case and Damage Ratings.
4. Figure 1B includes a step of “Present Analysis and Recommendation to Client.”
5. The Specification states: “Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.” Specification [00034]. *See also* Specification [00029],
6. Newell teaches that computer based tools that store litigation information in databases are known. Newell [0004] and [0103].
7. Newell teaches using a computer based user interface for accessing litigation information. Newell [0006] and [0101].

Claims 5-12 are rejected under 35 U.S.C. § 103(a) over admissions in Appellants' Specification and Newell. A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 399 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

Taking claim 5 as representative, as discussed above claim 5 encompasses an apparatus. The apparatus includes "interfaces for gathering selected information relevant to the decision" and "storage for gathered selected information." Claim 5 also recites an analyzer and a recommendation element for using the gathered information, weighted values, and resultant values to determine a recommended litigation decision. In as much as these limitations may be reasonably construed to encompass structures that perform the recited functions, we find that one of ordinary skill would have been led by admissions in the Appellants' Specification and Newell to an apparatus having the claimed structure.

The Appellants' Specification describes a prior art manual method (FF 1) which includes steps of gathering information (FF 2), a step of analyzing litigation information to determine a result (FF 3) and a step of presenting a recommendation to a client (FF 4). The Appellants also admit that it is within the general knowledge of an experienced lawyer to derive a weighted analysis. FF 5. However, the Appellants' Specification does not describe that it is known to implement the prior art manual method in an apparatus, such as a computer, having interfaces and storage.

However, "... it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. *In re Rundell*, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220[, 221] ["Appellant argues that his rejected claims rest upon an automatic mechanism. The mere statement that a device is to be operated automatically instead of by hand, without a claim specifying any particular automatic mechanism, is not the statement of an invention. *Marchand v. Emken*, 132 U. S. 195; *In re Gill*, 17 C. C. P. A. (Patents) 700, 36 F. (2d) 128."]" *In re Venner*, 120 USPQ 192, 194 (CCPA 1958). *Cf. Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) (One of ordinary skill in the art would have found it obvious to combine an old electromechanical device with electronic circuitry "to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. . . . The combination is thus the adaptation of an old idea or invention . . . using newer technology that is commonly available and understood in the art." *Id* at 1163.). We note that Newell teaches that computers having interfaces and storage are known in the art. FF 6-7.

We find that given the teachings of the admission of the Appellants' Specification and the teaching of Newell, one of ordinary skill in the art would have been led to the tool of claim 5. Accordingly, we reject claims 5-12, under 35 U.S.C. § 103(a) as being unpatentable over the admission in the Appellant's Specification and Newell.

DECISION

The decision of the Examiner to reject claims 1-4 is affirmed and to reject claims 5-12 is reversed. We enter a new ground of rejection on claims 5-12 under 35 U.S.C. § 103(a).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

mev

Appeal 2009-001491
Application 10/673,050

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